

REMARKS

In this response, Applicant does not present any claim amendments. Claims 1–18, 30, 31, 46, and 47 were previously canceled. No new matter is added by this response. Claims remaining in this application are:

Independent claims: 19, 29, 45

Dependent claims: 20–28, 32–44, 48–60

Rejections under 35 U.S.C. § 103

As summarized in the prior amendment and response, Applicant's claims are directed to a gaming method and device in which a bonus selection apparatus displays changeable bonus award amounts. These changeable bonus award amounts may be changed between base games or during the course of a base game. As discussed in the specification, these bonus award amounts may change randomly or in response to any number of conditions. As discussed in the specification at page 7, lines 4–8, the bonus award amounts are selected from a schedule of bonus award amounts. As discussed in the specification, the bonus awards may be selected in a weighted random manner so that certain bonus award amounts are selected more frequently than other bonus award amounts.

In addition to displaying the changeable bonus award amounts, the bonus selection apparatus also selects a bonus award amount upon the occurrence of a bonus trigger condition. Thus, the display of a changeable bonus award amount on the bonus selection apparatus does not guarantee that it will be selected and awarded since (1) the bonus selection apparatus may display more than one changeable bonus award available for selection and (2) a changeable bonus award

is only issued if it is selected after a bonus trigger condition. As discussed in the specification, the bonus trigger condition may relate to the base game or may be independent of the base game.

In rejecting the claims, Examiner cited various combinations of Demar, Boyd, and Seelig. However, in the office action, Examiner conceded that Demar and Boyd fail to teach or suggest a “changeable” bonus. See Office Action of July 1, 2010, pp. 3–4. Rather, Examiner relied entirely on Seelig to teach the feature of a “changeable” bonus.

Applicant respectfully submits that Seelig fails to disclose or suggest the changeable bonus as recited in the amended claims. Seelig discloses a slot machine game in which hidden bonuses are offered to the player and the player selects one hidden bonus from the selections offered. As stated in Seelig, “[o]nce indicator 44 has stopped, the player is given the opportunity to select one of the prize displays,” Seelig, ¶ [0044], and “[o]nce the player has selected the bonus prize display, bonus display 12 would display one or more bonus prizes won by the player,” *id.* at ¶ [0045]. In other words, as illustrated in both FIGS. 4 and 7 of Seelig, the bonus is displayed and the outcome is determined *after* a player selection is made. This is due to the game conduct of Seelig. In the first embodiment of Seelig, the player is presented with two selectable options. After the player selects either the “left bonus prize display 46 or the right bonus prize display 48,” the player’s selection is revealed. *Id.* at ¶ [0044]. In the second embodiment of Seelig, hidden prizes are displayed on a wheel. “The player is preferably allowed to stop prize display 212 or prize indicator 206 using input device 66.” *Id.* at ¶ [0075]. As Examiner would appreciate, if the prizes are displayed *before* the player enters a selection of a left or right prize or a selection to stop a wheel, the player would always choose the larger prize

or largest prize and the purpose of the game, namely to “allow[] players to participate in the selection of a bonus prize without affecting the game outcome or any prize that may be awarded,” would be defeated since the player would always pick the larger or largest prize. *Id.* at ¶ [0019]. Simply put, Seelig does not function if the gaming machine “display[s] said plurality of identified bonus award amounts on said plurality of changeable surface display elements” and selects a bonus award amount from the “plurality of changeable bonus award amounts *displayed* on said bonus selection apparatus” as recited in the independent claims. Thus, Applicant submits that Seelig teaches hidden random bonus awards rather than the displayed changeable bonus awards recited in the claims.

Moreover, because Seelig cannot be modified without defeating its principle of operation, Applicant submits that Seelig does not suggest the claimed invention. That is, “[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” MPEP § 2143.01(v) (citing In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). In this case, displaying the bonus prizes before the selection of a bonus prize would defeat Seelig’s purpose of player involvement in the selection of the bonus since the player would always select the larger bonus. Simply put, there is no game if the bonus prizes are not concealed from the player as described in Seelig.

In fact, Seelig teaches the opposite of the claimed invention. That is, Seelig teaches away from Applicant’s claims. Specifically, Applicant’s claims recite a computer processor that controls the *display* of changeable bonus awards and a *computer processor* selection of a bonus

award amount from the “plurality of changeable bonus award amounts, displayed on said bonus selection apparatus.” Seelig, on the other hand, only discloses a computer processor that controls the *concealment* of random bonus awards and a *player* selection of a bonus award from the two hidden awards. As Examiner is aware, “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious.”

MPEP § 2143.01(vi) (citing In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)).

Examiner concedes, and Applicant agrees, that the claim limitation of a changeable bonus displayed on a bonus selection apparatus is not taught by Boyd or Demar. As argued above, this claim limitation is not taught or suggested by Seelig. Because this claim limitation is recited in each independent claim 19, 29, and 45, and because the remaining claims depend from the allowable independent claims, Applicant submits that all claims are in condition for allowance.

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Conclusion

For the reasons advanced above, all pending claims are now believed to be in condition for allowance. Should Examiner believe that a telephone interview would advance the prosecution of this application, the undersigned would invite and request such an interview.

Respectfully submitted,
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